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EXAMINER

TRAN, HAI V

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/823,484	Applicant(s) CONNELLY, JAY H.	
	Examiner Hai Tran	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 05/05/2006 have been fully considered but they are not persuasive.

Applicant argues (see Applicant remark page 15, lines 7-30), "...the prior art combination of Seidman in view of Brown fails to teach or suggest each and every feature recited by claims 1, 15 and 25 as required to establish a *prima facie* case of obviousness."

In response, the Examiner respectfully disagrees with Applicant because, as indicated in the previous Office Action, Seidman discloses every feature Applicant claimed in claims 1, 15 and 25 except limitation "at least one available for broadcast data file for selective storage within the one or more client systems according to respective content rating tables of the one or more client systems and prior to broadcast of at least one of the plurality of upcoming data files by the broadcast service system". This claimed features are cured by the teaching of Brown, see Col. 12, lines 25-35 because Brown recording apparatus records the current broadcast program according to profile data and the current broadcast program is broadcasted prior to the future (i.e., coming up) broadcast of plurality of programs! As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Seidman to record at least one TV program on the user receiver according to user profile, as taught by Brown so the recorded program may be viewed at a later time. in view of that, the Examiner clearly establishes a *prima facie* case of obviousness.

In response to applicant's argument (see Applicant 's remark, page 16, page 22 and page 24) that "modification of Seidman to include such functionality would render Seidman unsatisfactory for its intended purpose ..." , a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant further argues (applicant's remark page 14, 18, 23, "Applicant respectfully submits that the disclosure of Seidman is limited to a single content provider that transmits a digital stream to a user which is a multiplex of streams that are coordinated for concurrent play (see, col. 5, lines 3-5)".

In response, the Examiner notes applicant's argument that the references "Seidman is limited to a single content provider", However, Applicant's remark is moot because claimed claims do not require the content provider to be single or many.

As to the remaining claims, Applicant does not distinctly and specifically point out errors in the Examiner Office Action but merely states the combination of the references fail to suggest each of the recited features of the claims. The examiner asserts again the combination of the references in the previous office action meets all the limitations of the claimed claims.

For at least the reason set forth above, the rejection is maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-2, 4, 6-8, 11-26, 28-29, and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seidman et al. (US 6298482) in view of Brown (US 6611842).

Claim 1, Seidman discloses a method, comprising:

Broadcasting meta-data to one or more client systems (Col. 7, lines 34-40, Col. 8, lines 16-35), including descriptions of a plurality of available for broadcast data files from a service provider system and a second plurality of upcoming data files to be broadcast to the one or more client system by a broadcast service system (Col. 5, lines 13-32; Col. 7, lines 39-55, data describing programming data, Col. 9, lines 20-40, plurality of program segments for viewing);

Rating the plurality of available for broadcast data files and the plurality of upcoming data files (Col. 6, lines 25-52; Col. 7, lines 63-67; Col. 8, lines 1-11, user ratings and profile of different shows); and

Broadcasting, by the service provider system according to the rating a plurality of data files to enable a user to navigate the concurrently transmitted

customized digital stream (Col. 3, lines 55-67; Col. 8, lines 20-50; Col. 9, lines 45-67; Col. 10, lines 1-6).

Seidman does not clearly disclose "at least one available for broadcast data file for selective storage within the one or more client systems according to respective content rating tables of the one or more client systems and prior to broadcast of at least one of the plurality of upcoming data files by the broadcast service system".

Brown discloses disclose "at least one available for broadcast data file for selective storage within the one or more client systems according to respective content rating tables of the one or more client systems and prior to broadcast of at least one of plurality of upcoming data files by the broadcast service system" (Col. 12, lines 25-35. Note: Brown recording apparatus records the current broadcast program according to profile data and the current broadcast program is broadcasted prior to the future broadcast of plurality of programs, i.e., TV program that is coming up in the next few hours). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Seidman to record at least one TV program on the user receiver according to user profile, as taught by Brown so the recorded program may be viewed at a later time.

Claim 2, Seidman (Col. 6, lines 40-67) further shows receiving rating of the plurality of available for broadcast data files and the plurality of upcoming data files from the one or more client systems;

Seidman (Col. 9, lines 20-45, 57-67; Col 10, lines 1-20, overlapping segments) further shows determining overlapping data files as data files from the selected data files to be broadcast by the broadcast service system; and

Seidman (Col. 9, lines 10-55, displaying the program segment most relative to user interest and suppressing additional segments) further shows eliminating, from the selected data files, the overlapping data files to form a subset of the plurality of available for broadcast data files to be broadcast to the one or more client systems by the service provider.

Seidman does not show selecting data files from the 1st and 2nd plurality of data files, which have higher ratings, based on the received ratings;

Brown (Fig. 4-7; Col. 5, lines 20-Col. 11, lines 61) shows selecting data files from the 1st and 2nd plurality of data files which have higher ratings based on the received ratings; Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Seidman with the ability to choose segments based on higher rating, as taught by Brown, so that user able to receive the most relevant/interest program.

Regarding Claim 4, Seidman shows that a variety of hyperlinks are sent to the user then the user selects the hyperlink, effectively sending the meta-data (col. 7 lines 28-38, col. 8 lines 19-45, selection of hyperlink sends user relevant metadata, hyperlink is effectively scheduling the display of data).

Claim 6, Seidman shows a method, comprising

Receiving meta-data, the meta-data including descriptions of a plurality of available for broadcast data files from a service provider system and a plurality of upcoming data files to be broadcast service system (Col. 5, lines 13-32; Col. 7, lines 39-55, data describing programming data, Col. 9, lines 20-40, plurality of program segments for viewing);

Rating, in response to a content rating table, at least one of the plurality of available for broadcast and upcoming data files described by the meta-data, the content rating table generated responsive to a user (Col. 6, lines 25-52; Col. 7, lines 63-67; Col. 8, lines 1-11, user ratings and profile of different shows);

Receiving at least one of an upcoming data file broadcast by the service provider system and an available for broadcast data files broadcast by the broadcast service system (Col. 3, lines 55-67; Col. 8, lines 20-50; Col. 9, lines 45-67; Col. 10, lines 1-6); and

Seidman does not clearly show "Storing, based on the content rating table, one of the received available for broadcast data file broadcast by the broadcast service system and the receiving upcoming data files broadcast by the service provider system."

Brown discloses "Storing, based on the content rating table, one of the received available for broadcast data file broadcast by the broadcast service system and the receiving upcoming data files broadcast by the service provider system." (Col. 12, lines 25-35). Therefore, it would have been obvious to one of ordinary skill

in the art at the time the invention was made to modify Seidman to record at least one TV program on the user receiver according to user profile, as taught by Brown so the recorded program may be viewed at a later time.

Claim 7, Seidman in view of Brown shows transmitting the user ratings to the service provider (col. 6, lines 40-67, sending user history and preferences to head end).

Claim 8, Seidman (Col. 5, lines 13-22; Col. 6, lines 65-67; Col. 9, lines 45-67; Col. 10, lines 1-6) in view of Brown (Col. 12, lines 25-35) discloses broadcasting a service provider broadcast schedule of the subset of the plurality of available data files prior to broadcasting the subset of the plurality of available for broadcast data files to enable storage thereof by the one or more client systems; Seidman further shows that a variety of hyperlinks are sent to the user, then the user selects the hyperlink, effectively sending the meta-data (col. 7 lines 28-38, col. 8 lines 19-45, selection of hyperlink sends user relevant metadata, hyperlink is effectively scheduling the display of data). Seidman further shows a (program menu" and additional data pertaining to broadcast times (col. 5 lines 13-22, col. 6 lines 65-67).

Claim 11, Seidman further shows storing data files in memory for the user's eventual selection (col. 9 lines 45-67, storing overlapping segments). Although not

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specifically stated it is nonetheless inherent that the STB uses memory, or a digital disk to store this data.

Claim 12 is analyzed with respect to claim 6.

Claim 13 is analyzed with respect to claim 7.

Claim 14 is analyzed with respect to claim 8.

Claim 15, the apparatus claim is analyzed with respect to the method claim 1 in which limitations “a processor, a communication interface and storage device” are inherently met by Seidman in view of Brown so to perform as disclosed.

Claim 16, Brown (Fig. 4-7; Col. 5, lines 20-Col. 11, lines 61) further shows selecting data files from the plurality of upcoming and available for broadcast data files which have higher ratings based on the received ratings;

Claim 17, is analyzed with respect to method claim 2.

Claim 18, Seidman (Col. 5, lines 13-22; Col. 6, lines 65-67; Col. 9, lines 45-67; Col. 10, lines 1-6) in view of Brown (Col. 12, lines 25-35) discloses broadcast schedule of the subset of the plurality of available data files prior to broadcasting the subset of the plurality of available for broadcast data files.

Claim 19, the apparatus claim is analyzed with respect to method claim 6 in which limitations “a processor, a communication interface and storage device” are inherently met by Seidman in view of Brown so to perform as disclosed.

Claim 20, Seidman in view of Brown shows transmitting the user ratings to the service provider (col. 6, lines 40-67, sending user history and preferences to head end).

Claim 21, the apparatus claim is analyzed with respect to method claim 8.

Claim 22, the apparatus claim 22 is analyzed with respect to method claim 12.

Claim 23, Seidman in view of Brown shows transmitting the user ratings to the service provider (col. 6, lines 40-67, sending user history and preferences to head end).

Claim 24, the apparatus claim is analyzed with respect to method claim 14.

Claim 25, a machine-readable medium having instruction stored thereon, which when executed by a processor is analyzed with respect to method claim 1.

Claim 26, Brown (Fig. 4-7; Col. 5, lines 20-Col. 11, lines 61) further shows selecting data files from the plurality of upcoming and available for broadcast data files which have higher ratings based on the received ratings;

Claim 28, a machine-readable medium having instruction stored thereon, which when executed by a processor is analyzed with respect to method claim 6.

Claim 33, Seidman in view of Brown (Col. 12, lines 25-35) further disclose place each stored data file in a common repository irrespective of a content provider of the data file, such that a user can access a single location for selecting stored content data files.

Claim 34 is analyzed with respect to claims 1-2, and 4 in which Seidman further shows a service provider broadcast server (col. 4 lines 30-40, head end with media content), and one or more client systems coupled to the service provider broadcast server (col. 4 lines 30-57, user STB connected to head end), wherein meta-data is broadcast to the one or more client systems, the meta-data including descriptions of a plurality of available for broadcast data files from the service provider broadcast server and a plurality of data files to be broadcast to one or more client system by a broadcast service system (col. 7 lines 34-40, col. 8 lines 16-35, embedded hyperlink data, col. 5 lines 13-22, col. 7 lines 39-55, data describing programming data, col. 9 lines 20-40, plurality of program segments for viewing), wherein the one or more client systems rate, one or more of the plurality of data files described by the meta-data (col. 6 lines 25-52, col. 7 lines 63-67, col. 8 lines 1-11, user ratings and profile of different shows) the content rating table generated responsive to data files previously accessed (col. 5 lines 53-63, storing viewer's previous selections, col. 6 lines 2-8), wherein the one or more client systems

transmit, to the service provider broadcast server, the ratings of the plurality of data files (col. 6 lines 40-67, sending user history and preferences to head end).

Claim 35, Brown discloses the client system selectively store data file broadcast by the broadcast service system based on the content rating table, and the receiving upcoming data files broadcast by the service provider system (Col. 12, lines 25-35).

Claim 36, Seidman (Col. 5, lines 13-22; Col. 6, lines 65-67; Col. 9, lines 45-67; Col. 10, lines 1-6) in view of Brown (Col. 12, lines 25-35) discloses wherein the client system selectively receive data files from the selected subset of the plurality of available for broadcast and upcoming data files according to a content rating table associated with each respective one of the one or more of client systems.

2. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seidman et al. (US 6298482) in view of Brown (US 6611842), and further in view of Ten Kate et al. (US 6601237).

Claim 3, Seidman (Col. 5, lines 13-22; Col. 6, lines 65-67; Col. 9, lines 45-67; Col. 10, lines 1-6) in view of Brown (Col. 12, lines 25-35) discloses broadcasting a service provider broadcast schedule of the subset of the plurality of available data

files prior to broadcasting the subset of the plurality of available for broadcast data files to enable storage thereof by the one or more client systems;

Seidman in view of Brown does not clearly disclose "broadcasting a broadcast schedule for the overlapping data files prior to broadcast by the broadcast service system".

Ten Kate shows broadcasting numerous amounts of schedule data pertaining to the program segments and overlapping segments (Col. 1, lines 22-36; Col. 2, lines 5-20; Col. 4, lines 50-67., program schedule data describing parameters of broadcast segments). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Seidman in view of Brown with the ability to broadcast numerous amounts of schedule data, as taught by Ten Kate, so that user would be provided with the most relevant data pertaining to a program and allow the system to compare different entries.

3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seidman et al. (US 6298482) in view of Brown (US 6611842), and further in view of Ballou. Jr et al. (2002/0112235).

Claim 5, Seidman in view of Brown fail to show receiving compensation for a stored data file and dividing compensation between the service provider and broadcast service system based on the portion provided.

Ballou shows receiving compensation for a stored data file (page 4 section 0038, receiving ID to charge credit account) and dividing compensation between the content provider and distributor (page 6 section 0063-0064, dividing compensation between distributor and content provider). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Seidman in view of Brown with the ability to charge per viewing and divide compensation, as taught in Ballou, so that the multiple providers would receive maximum compensation and the appropriate compensation would go to each.

4. Claims 9-10, and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seidman et al. (US 6298482) in view of Brown (US 6611842), and further in view of Ten Kate et al. (US 6601237), and further in view of Ballou, Jr et al. (2002/0112235).

Regarding Claim 9, Seidman (col. 9 lines 45-67, storing segments and user selecting appropriate segment) in view of Brown shows receiving a selection for a stored data file.

Seidman in view of Brown fails to show determining the service provider.

Ten Kate shows the ability to determine information about content provider (col. 4 lines 35-67, SDT listing parameters of service for broadcast stream). It would have been obvious to one of ordinary skill in the art at the time the invention was

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made to modify Seidman in view of Brown with the ability to determine the service provider, as in Ten Kate, so the system would know the source of the stream.

Seidman in of brown and Ten Kate fail to show billing the user a predetermined amount for selection of the stored data based on content provider information.

Ballou shows billing the user a predetermined amount for selection of the stored data based on content provider information (page 4 section 0038, receiving m to charge credit account, page 6 sections 0063-0065, billing according to multiple factors). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Seidman in of brown and Ten Kate with the ability to charge per viewing, as taught by Ballou, so that the multiple providers would receive maximum compensation.

Regarding Claim 10, Seidman in view of Brown fails to show determining the service provider.

Ten Kate shows the ability to determine information about content provider (col. 4 lines 35-67, SDT listing parameters of service for broadcast stream). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Seidman in view of Brown with the ability to determine the service provider, as in Ten Kate, so the system would know the source of the stream.

Seidman in of brown and Ten Kate fail to show receiving compensation for a stored data file and dividing compensation between the service provider and

broadcast service system based on the portion provided. Ballou shows receiving compensation for a stored data file (page 4 section 0038, receiving ID to charge credit account) and dividing compensation between the content provider and distributor (page 6 section 0063-0064, dividing compensation between distributor and content provider). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Seidman in of brown and Ten Kate with the ability to charge per viewing and divide compensation, as taught in Ballou, so that the multiple providers would receive maximum compensation and the appropriate compensation would go to each.

Claim 31, see analysis of claim 9.

Claim 32, see analysis of claim 10.

5. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seidman et al (6,298,482) in view of Brown (US 6611842) and further in view of Barton et al (6,490,722).

Regarding Claim 30, Although Seidman shows that segments are stored and it is inherent new segments can be stored (col. 9-10, lines 47-1%, he fails to specifically state the ability to remove data files stored on a client system once viewed by a user, and replace deleted data files with additional data files broadcast by the service provider system and the broadcast service system.

Barton shows the ability to remove data files stored on a client system once viewed by a user, and replace deleted data files with additional data files broadcast by the service provider system and the broadcast service system (col. 18.1ines 64-67, col. 19 lines 1-7, deleting previously viewed segments and replacing with new segments). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Seidman in view of Brown with the ability to erase older segments and store new segments, as taught in Barton, so that the user would be supplied with a continuous stream of viewing material.

6. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seidman et al (6,298,482) in view of Brown (US 6611842) and further in view of Ali (2002/0199194).

Claim 27, Seidman in view of Brown shows user ratings and preferences they both fail to specifically state that all of the users' rating are combined to form an overall ratings list.

Ali shows combining multiple users' ratings to form an overall ratings list (page 3 section 0027, list of rated items are aggregated with the rated items from many other users into a single list). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Seidman in view of Brown with the ability to aggregate multiple users' ratings, as shown in Ali, so that suggestions could be made to the user of recommended shows.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is (571) 272-7305. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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07/21/2006



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PRIMARY EXAMINER